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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,258	02/03/2004	James F. Cheatham	21321-0008	2443

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EXAMINER

VANAMAN, FRANK BENNETT

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/771,258

Applicant(s)

CHEATHAM ET AL.

Examiner

Frank Vanaman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Application

1. Applicant's amendment, filed Feb. 16, 2006, has been entered in the application. Claims 38-62 are pending.

Claim Objections

2. Claim 55 is objected to because of the following informalities: in claim 55, line 1, it appears as though "on embossment" should be - one embossment- -. Appropriate correction is required.

Recapture

3. Claims 41 and 60 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Each claim lacks the limitation that the spacers have specifically been coined as set forth in the specification. Each independent claim of the allowed application (08/902,449) included the limitation that the spacers be coined. Further, applicant argued in several amendments that this limitation specifically is pointed out as defining beyond the prior art. See paper 8 of the '449 application, at page 12, wherein the prior art is identified as lacking this limitation, paper 9 at pages 4-5, paper 11, pages 2-8 which goes into substantial detail describing the use of a coined spacer and how the presence of this limitation defines beyond the prior art, and paper 16, including both the amendments to the claims, and the comments on page 5. Thus the inclusion of the limitation in the patented claims that the spacer elements be coined was not an error.

Applicant has argued that countersinking or counterpressing is narrower than coining, however the examiner notes that the forming of a 'configuration' as recited in claims 41 and 60 is not equivalent to an explicit counter sinking or counterpressing process, which applicant is apparently attempting to assert. The fact remains that these claims fail to mention coining, which limitation was specifically added by applicant and which was specifically argued as having been added to define beyond the prior art.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 38-40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soo (US 5,129,663). Soo teaches an in-line skate frame which may be made, comprising a single element, the frame forming a channel with a top, side walls (10) and a bottom, the top including plural flanges (8) for accommodating footwear (9), the side walls extending downwardly from the top and extending in a longitudinal direction of the skate, the frame further including apertures (13) for accommodating skate wheel axles for mounting skate wheels (3), the apertures surrounded by spacers extending inwardly from the side walls and having an outer countersunk recess (see figure 5) and a truncated cylindrical shape directed inwardly (14). Soo fails to specifically teach the material from which the frame is made, however in view of metal having a substantially high strength, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the skate frame from a metal for the purpose of providing the frame with substantially high strength, so as to ensure its longevity under strenuous skating activity. As regards the limitations of the formation of the spacers by countersinking or counterpressing as recited in association with the apparatus claims, the taught structure of the apparatus includes the physical characteristics required by the claim recitation (i.e., the recessed faces on the exterior surfaces) and thus is not patentably distinct from a skate structure formed by the process steps recited in the claim.

6. Claims 44-47, 49, 51-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit (6,301,771, filed 10/1996). Benoit teaches an in-line skate

frame and method of making such a frame, comprising either multiple pieces or a single piece of aluminum, the frame forming a channel with a top, side walls (2) and a bottom, the top including plural flanges (3, 4) for accommodating footwear, the side walls extending downwardly from the top and extending in a longitudinal direction of the skate, being generally parallel with one another, further including at least one embossment (19) on each side, and wherein the sides proximate a top thereof taper towards one another (figure 3, for example), the frame being formed by a pressing process into an appropriate shape, the frame further including apertures (6) for accommodating skate wheel axles for mounting skate wheels, the apertures surrounded by spacers extending inwardly from the side walls (7) and having a truncated cylindrical shape formed by a pressing process (specifically die forging).

The reference to Benoit fails to specifically teach that the cylindrical spacers are formed by coining, however in that coining is a closed die forging process, and that Benoit teaches a generalized die forging process, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the spaces by the closed die forging process (i.e., coining) in order to ensure the formation of a smooth face.

The reference to Benoit fails to teach the formation of holes, followed by the formation of spacers. The reversal of forming steps is not deemed to be beyond the skill of the ordinary practitioner, and in this case, it would have been obvious to first form the holes, and then form the spacers, in order to facilitate and allow the use of plural drilling templates, e.g., having different numbers of wheels, or wheel spacings, allowing the centering of the dies(s) based on a desired predetermined hole spacing.

Further, as regards the process steps as presented in the apparatus claims, the taught structure of the apparatus includes the physical characteristics required by the claim recitation (i.e., the recessed faces on the exterior surfaces) and thus is not patentably distinct from a skate structure formed by the process steps recited in the claim.

As regards the provision of footwear, wheel axles and wheels, each of these elements is very old and well known in the skate making art as being used for a skate, and particularly in that Benoit teaches the skate frame as being adapted to

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accommodate these elements (col. 3, lines 16-20, col. 3, line 28), it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the skate frame taught by Benoit with an element of footwear, wheels and wheel axles for the purpose of providing a complete and functional skate.

7. Claims 38-43 and 57-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit (6,301,771, filed 10/1996) in view of Hilgarth (US 6,015,157, filed 4/1997). Benoit teaches an in-line skate frame and method of making such a frame, comprising either multiple pieces or a single piece of aluminum, the frame forming a channel with a top, side walls (2) and a bottom, the top including plural flanges (3, 4) for accommodating footwear, the side walls extending downwardly from the top and extending in a longitudinal direction of the skate, the frame being formed by a pressing process into an appropriate shape, the frame further including apertures (6) for accommodating skate wheel axles for mounting skate wheels, the apertures surrounded by spacers extending inwardly from the side walls (7) and having a truncated cylindrical shape formed by a pressing process (specifically die forging). As regards the provision of wheel axles and wheels (claims 39, 40), each of these elements is very old and well known in the skate making art as being used for a skate, and particularly in that Benoit teaches the skate frame as being adapted to accommodate these elements (col. 3, lines 16-20, col. 3, line 28), it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the skate frame taught by Benoit with an element of footwear, wheels and wheel axles for the purpose of providing a complete and functional skate. As regards claim 42, the reference to Benoit fails to teach the formation of holes, followed by the formation of the spacers. The reversal of forming steps is not deemed to be beyond the skill of the ordinary practitioner, and in this case, it would have been obvious to first form the holes, and then form the spacers, in order to facilitate and allow the use of plural drilling templates, e.g., having different numbers of wheels, or wheel- spacings, allowing the centering of the die(s) based on a desired hole spacing.

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Benoit fails to specifically teach a countersink on the exterior face of the sides. Hilgarth teaches that it is well known to provide a countersink (38) on a skate frame side, with an accompanying inwardly extending truncated cylinder to accommodate an axle end. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the frame side taught by Benoit with a countersink as taught by Hilgarth for the purpose of providing a protected region for the end of the wheel supporting axle, the motivation being expressly set forth in Hilgarth at col. 8, lines 61-63.

8. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit (6,301,771, filed 10/1996) in view of Rudolph (US 6,047,972, filed 11/1997, 7/1996). The reference to Benoit is discussed above and fails to teach at least one supporting brace extending between the sides of the frame. Rudolph teaches a skate frame having a pair of sides (20) and a plurality of braces (generally 24, figure 1), for enhancing the rigidity of the frame. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the skate from of Benoit with at least one brace as taught by Rudolph for the purpose of enhancing the rigidity of the frame under strenuous skating conditions.

9. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Benoit (6,301,771, filed 10/1996) in view of Miller (US 2,533,277). The reference to Benoit is discussed above and fails to teach a gusset formed between one of the flanges and sides of the frame. Miller teaches a skate frame formed from a piece of metal wherein a footwear-supporting flange portion (24, 27) and a vertical side portion (21) are provided with at least one reinforcing gusset (49) to strengthen the frame. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide at least one gusset as taught by Miller at the juncture of the sides and flange of the skate frame taught by Benoit, for the purpose of strengthening the frame and the juncture of the flange and sides.

Response to Comments

10. Applicant's comments concerning particular limitations associated with the term 'coining' are noted, however it appears applicant is relying on material beyond that which is supported in the application as originally filed. As the examiner has noted previously, care should be taken to note applicant's specific words associated with the limitation of coining and applicant's definition thereof, which can be determined from the published patent document of applicant's granted patent, at col. 2, lines 23-24 and at col. 4, lines 59-62, which are understood to comprise the definition of coining to the extent expressed by applicant.

Applicant's comments directed to the reference of Benoit as effectively teaching away from the claimed material are not persuasive, inasmuch as they appear to be a misinterpretation of that which Benoit actually sets forth. Note that Benoit teaches that manufacturing by a process which may include die forging is more precise and lacks a requirement for further machining, as opposed to injection or molding - and while applicant refers to subsequent machining, it appears that the die forging referred to by Benoit constitutes a final step, as indeed applicant's coining step does as well. As regards the provision of a countersunk region, note that Hilgarth teaches such a limitation to the breadth it is actually claimed, and is applied in combination where such a limitation is set forth. It appears, in general, throughout the arguments, that applicant is asserting limitations to be associated with the claims to a scope different than that of the actual claim recitation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The court explained that "reading a claim in light of the specification, to thereby interpret

limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim." The court found that applicant was advocating the latter, i.e., the impermissible importation of subject matter from the specification into the claim.). See also *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)

Applicant's comments concerning the manufacture of the frame including a process associated with coining are noted, however applicant is reminded that the process for manufacturing a product (in an apparatus claim) does not serve to provide a patentable distinction. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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1. Any inquiry specifically concerning this communication or earlier communications from the examiner should be directed to F. Vanaman whose telephone number is 571-272-6701.

Any inquiries of a general nature or relating to the status of this application may be made through either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A response to this action should be mailed to:

Mail Stop _____
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450,

Or faxed to:

PTO Central Fax: 571-273-8300

F. VANAMAN
Primary Examiner
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A handwritten signature in black ink, appearing to read 'F. Vanaman', with a date '5/1/08' written below it.